

**REMARKS**

Claims 1-5, claims previously indicated allowable resulting from a Pre-appeal proceeding, have again been rejected as allegedly being rendered obvious over a combination of a newly cited reference with the formerly cited references. The Examiner has now identified Japanese Patent reference Kumano et al JP405193249A for tenebrescent/disappearing ink and has advance rejections under 35 U.S.C. 103 of claims 1-3 and 5 over that publication in view of the previously-cited Sherman patent (USP 4,987,849). For his rejection of claim 4, the Examiner added the previously-cited Pitts patent (USP 5,698,297). Applicant respectfully submits that the claims of record are patentable over the art of record and respectfully traverses.

In the August 31, 2006 Office Action, the Examiner contends that combining Kumano et al with Sherman would have been obvious to the skilled artisan "for the purpose of not starting the disappearing reaction until the desired time." *See page 3*. Notably, the teachings in Kumano et al publication relied upon by the Examiner are virtually the same as those previously relied on by the Examiner in rejecting the claims:

Kumano discloses a sheet of indicia printed there on which disappear over time when in contact with vapor, oxygen or ultraviolet rays in air.

*See Page 2 August 31, 2006 Office Action*

...a marked area (surface 14) having ink capable of disappearing (ink 3), an overlying barrier sheet (12) for preventing permeation of air which is removably affixed to the marking surface (Col 3 , lines 4-11)

*See Page 3 March 1, 2006 Final and Page 4 August 26, 2005 Office Action.*

The Examiner correctly observes that Kumano et al does not teach, disclose or suggest the use of an overlying polymeric sheet or aluminum foil and further that the teachings of Kumano et al and the previously-cited Sherman patent are similar. However, the Examiner avers that the purpose of Kumano et al is "considered to be penmanship improving indicia," a notion utterly absent from Kumano et al.

As developed herein, the combination of Kumano et al with Sherman not only is believed to be improper for rejecting the claims under 35 U.S.C. §103(a) but also fails even to achieve the claimed invention of claim 1. The cited prior art, in particular Kumano et al and Sherman, fails to teach, or even suggest "a marking area comprising penmanship improving indicia comprising ink capable of disappearing." Both disclose disappearing ink. In the case of Kumano et al, the tenebrescent ink is applied during printing which oxidizes and disappears when contacted with an appropriate energy source (heat electromagnetic radiation, etc.). Neither reference discloses that the surface comprises indicia for assisting a user to write a message more legibly, a clear point of novelty of the present invention.

Like Sherman as already argued in the Pre-Appeal Brief, Kumano et al does not teach, disclose, or suggest, "a marking area comprising penmanship improving indicia comprising ink capable of disappearing" as required in claim 1. Hence, Applicant's previous arguments that it would not have been obvious to one of skill in the art to provide the disappearing ink of Sherman in the claimed manner, i.e., as penmanship improving indicia comprising disappearing ink, are equally applicable to Kumano et al.

Examination of the content of the Kumano et al patent publication, demonstrates that it does not recite, describe, disclose, or suggest penmanship improving indicia. Rather, the clearly delineated purpose of Kumano et al is for recycling of a misprinted sheet:

Therefore, the misprint form printed including a miswritten word of the omission of a word had the fault which cannot be again used in a firm [sic]....to offer a printing approach which enabled it to use again the form ...without regenerating paper.

*See Paragraph 003.*

Due to its intended use, Kumano et al teaches use of inks subject to "tenebrescence" (reverse photochromism) triggered by "touching" [sic] (exposure) of the colored ink by ultraviolet radiation, steam, or heat. As such the ink always disappears with the passage of time, e.g., 2 days. *See Paragraph 009.*

In contrast to the element in the present invention for a marking area comprising penmanship improving indicia, Kumano et al addresses an expedient (disappearing ink) for reuse of a printing sheet/substrate in the event of a printing mistake. In essence, this teaching is no more relevant or even different than the already-considered Sherman patent, alone, or in combination with the cited Pitts reference. Regardless, the Examiner appears to be reiterating the previously-expressed contention the card assembly and the desired information to be displayed is not patentably significant. But this very notion has already been rejected by in the Pre-Appeal review which in effect, accepted Applicant's arguments that the Examiner's combination of Sherman and Pitts provided insufficient basis under 35 U.S.C. § 103 to render the claimed invention under

claims 1-5 obvious. In the absence of such a basis, no *prima facie* case of obviousness can be established.

Moving to another issue relating to the Examiner's rejection, absent impermissible hindsight reconstruction, the invention of claim 1 remains patentable over the combination of Sherman and Kumano et al.

At its core, our anti-hindsight jurisprudence is a test that rests on the unremarkable premise that legal determinations of obviousness, as with such determinations generally, should be based on evidence rather than on mere speculation or conjecture. Our court's analysis in *Kahn* bears repeating:

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as "the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of Board determinations], which ensures due process and non-arbitrary decisionmaking, as it is in § 103.

*Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1289 (Fed. Cir. 2006), *citing In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006) (*quoting In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)).

In the August 31, 2006 Office Action, the Examiner did not articulate a clear rationale as to why a skilled artisan would be motivated to achieve the claimed elements including penmanship improving indicia with the writing surface from the teachings of Kumano et al with Sherman. In the absence of such a showing, let alone meeting the limitations of the claimed invention, a finding of unpatentability is inconsistent with the

May 26, 2006 decision of the Panel. The Examiner's reliance on the combinations based on newly cited Kumano et al disappearing ink patent fails for the same reasons as did the Sherman patent.

Reliance on Applicant's claims as a template for combining the cited references amounts to no more than impermissible hindsight. Nowhere in the record, other than in Applicant's specification, is the idea of using disappearing ink to make the penmanship improving indicia even remotely considered an, thus, no *prima facie* case of obviousness has been established for any of claims 1-5 and the 103 rejection of these claims should be overturned. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 682; *see also In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references). It is well established that, even if all aspects of the claimed invention were individually known in the art, such is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). Thus, it is incumbent upon the Examiner to provide some suggestion of the desirability of doing what the inventor has done in his formulation, imposition and maintenance of a rejection under 35 U.S.C. 103(a). "To support the conclusion that the claimed invention

is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). But here, based on the content of the Office Action, the Examiner appears to have impermissibly relied on the teachings of Applicant's patent.

Accordingly, consistent with the decision of the Pre-Appeal Panel, claim 1 defines patentable subject matter over the cited prior art and the rejection of claim 1 should be withdrawn.

Claims 2, 3 and 5 likewise, remain patentable over the prior art of record at a minimum due to their dependence on independent claim 1.

Turning to the rejection of claim 4 as being obvious over the combination of Kumano et al and Sherman further in view of Pitts. Like Sherman, disappearing ink may be disclosed in Kumano et al and guide marks for a writing surface may be disclosed in Pitts. However, as explained in detail in Applicant's response dated October 19, 2005, e.g., at pp. 8-9, that were favorably reviewed by the Pre-Appeal Panel, Pitts merely discloses alternative guide structures but nowhere discloses, suggests or motivates combination with disappearing ink. (This argument is equally apt in the case of the Kumano et al tenebrescent ink.)

Accordingly, the proposed combination of Kumano et al with Sherman and Pitts does not teach or suggest a marking area with penmanship improving indicia that

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**PATENT**

disappears upon the initiation of a chemical reaction that occurs when a barrier sheet is removed from the marking area.

In view of the foregoing, Applicant respectfully submits that the present invention as set forth in independent claim 1 is patentable over the art of record. With respect to the dependent claims, Applicant respectfully submits that if an independent claim is free of the art, then any claim depending therefrom is also free of the art. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Accordingly, Applicant respectfully submits that the present invention is patentable over the art of record.

In view of the remarks above, Applicant respectfully submits that the present application is in condition for immediate allowance with at least claims 1-5 and such action is hereby solicited.

Respectfully submitted,  
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